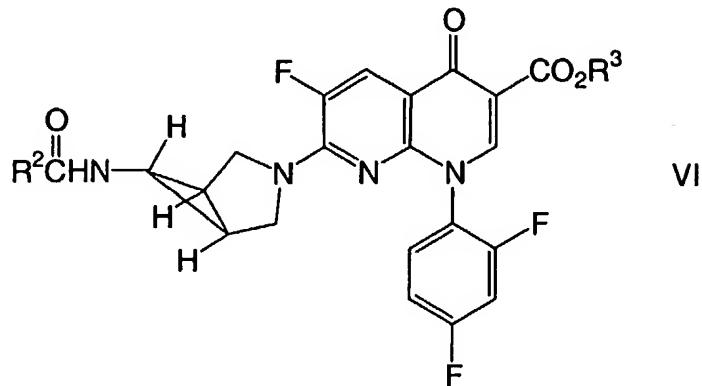
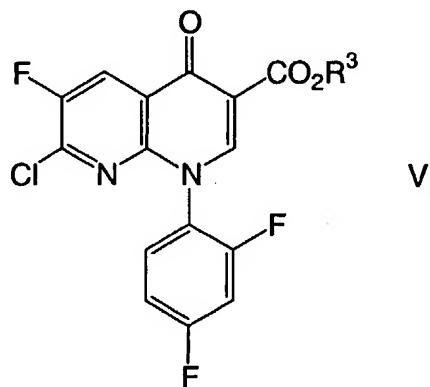


APPENDIX A  
CLAIMS UNDER APPEAL

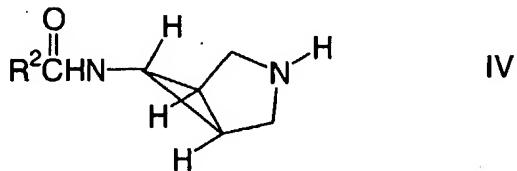
8. A process for the preparation of a compound of the formula



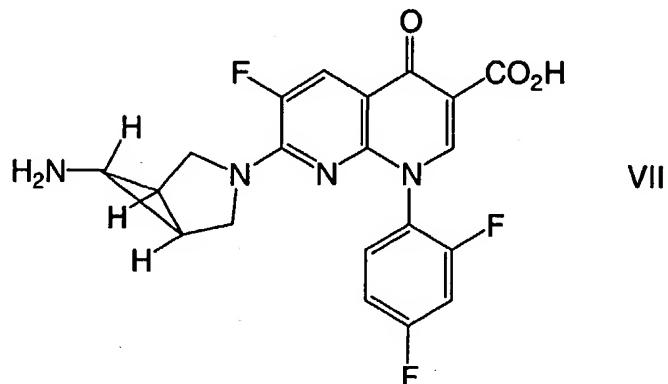
wherein  $R^2$  is  $C_1-C_6$  alkyl, trifluoromethyl, or phenyl which may be substituted by one or more of  $C_1-C_6$  alkyl,  $C_1-C_6$  alkoxy, halo, nitro, amino or trifluoromethyl, and  $R^3$  is  $C_1-C_6$  alkyl, which comprises reacting a compound of the formula



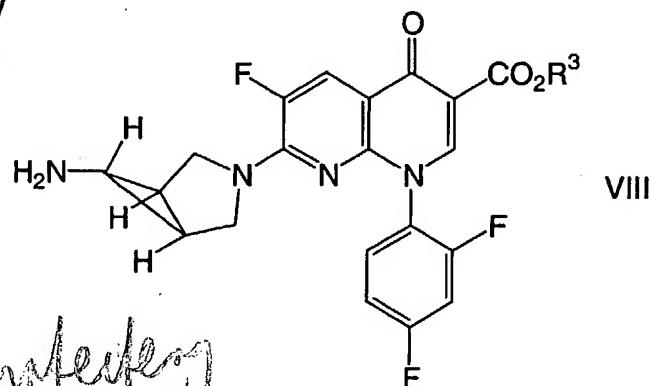
with a compound of the formula



9. A process comprising hydrolysis of the compound of formula VI with methanesulfonic acid, water and an organic solvent to form a monomethanesulfonic acid salt of a compound of the formula



10. A process comprising hydrolysis of the compound of formula VI with methanesulfonic acid and R<sup>3</sup>OH wherein R<sup>3</sup> is C<sub>1</sub>-C<sub>6</sub> alkyl to form a monomethanesulfonic acid salt of a compound of the formula



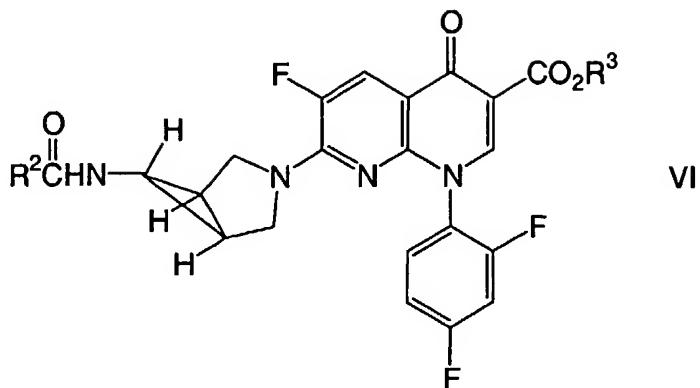
*Opposite*

*of amine*

*form<sup>3</sup>*

*Ref. 36  
(12) 5027 (1988) = 251.09*

### 11. A compound of the formula



wherein

$R^2$  is  $C_1$ - $C_6$  alkyl, trifluoromethyl, or phenyl which may be substituted by one or more of  $C_1$ - $C_6$  alkyl,  $C_1$ - $C_6$  alkoxy, halo, nitro, amino or trifluoromethyl, and

R<sup>3</sup> is C<sub>1</sub>-C<sub>6</sub> alkyl.

Claims 8-11. Appellants submit this Brief, in triplicate, to support the Notice of Appeal.

Payment authorization, for filing this Brief On Appeal, is provided by the concurrently filed Transmittal Letter.

A request for a two-month extension of time, and the authorization for payment of the appropriate fee, is separately enclosed herewith.

I. Real Party in Interest

The present application, listing the Charles K. Chiu and Lewin T. Wint, is owned in its entirety by Pfizer Inc.

II. Related Appeals and Interferences

There are no other appeals or interferences, known to Appellants or Appellants' Attorney, relating to the present application, which will directly affect, be directly affected by, or have a bearing on the Board's decision on the pending appeal.

III. Status of Claims

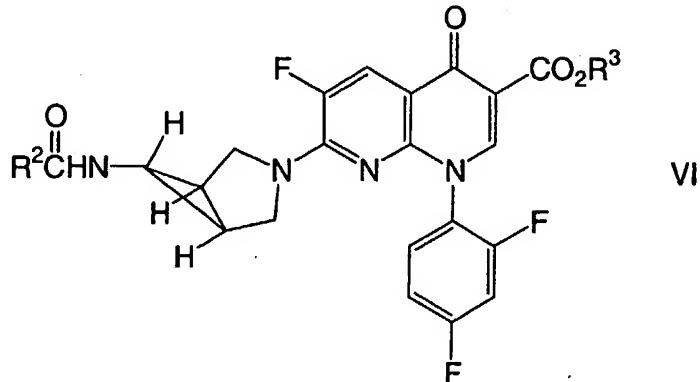
Claims 8-11 are currently pending in the present application. Claims 8-11, which are attached as Appendix A, are final rejected under 35 USC 112, first paragraph. Claim 8 also stands final rejected under 35 USC 112, second paragraph.

IV. Status of Amendments

No amendments have been filed in the present application subsequent to the final rejection.

V. Summary of the Invention

The present invention, as claimed in independent Claim 8, is directed to a method for making a compound having the structure of Formula IV, shown below.



wherein R<sup>2</sup> is C<sub>1</sub>-C<sub>6</sub> alkyl, trifluoromethyl, or phenyl which may be substituted by one or more of C<sub>1</sub>-C<sub>6</sub> alkyl, C<sub>1</sub>-C<sub>6</sub> alkoxy, halo, nitro, amino or trifluoromethyl.

The invention of Claim 11 is directed to a compound of Formula VI.

VI. Issues

- A. Whether Claims 8-11 are properly rejected under 35 USC 112, first paragraph.
- B. Whether Claim 8 is properly rejected under 35 USC 112, second paragraph.

VII. Grouping of Claims

Claims 8-11 are one group. It is respectfully requested that the Board select Claim 8 to decide the appeal as to the grounds of the rejection of Claims 8-11.

## VIII. Argument

### **A. A Rejection, Under 35 USC 112, First Paragraph, for not Enabling One Skilled in the Art to Make a Compound Having 3 or More Nitro or Amino Groups on a Phenyl Ring, Is Not Proper**

Claims 8-11 are rejected under 35 USC §112, first paragraph, as not enabling one skilled in the art to make the invention. The Examiner states that while the Specification provides enablement for  $R^2$  equaling 1 to 2 nitro, or amine, groups on the phenyl in a meta position, the Specification does not provide enablement for a phenyl  $R^2$  group that is substituted 3 or more times with nitro or amino groups. Further, the Examiner states, without providing any basis of support, that no compound has ever been synthesized where a phenyl ring can support electron-withdrawing groups, such as nitro, in the ortho position.

Contrary to the Examiner's statement, the Specification does enable one of skill in the art to make and use the invention of Claims 8-11.

The purpose of the enablement provision is to assure that the inventor provides sufficient information about the claimed invention so that a person of skill in the art can make and use it without undue experimentation relying on the Specification and the knowledge in the art. (See *Scripps Clinic & Research Foundation v. Genentech, Inc.*, 18 USPQ2d 1896 (Fed. Cir. 1991).)

Contrary to the Examiner's statement, phenyl compounds, and processes, are known in the art for producing phenyl compounds that (1) are substituted at the ortho position with a nitro or amino group, and (2) are substituted 3 or more times with nitro and amino groups. Numerous examples

of such compounds are present in the American Chemical Society registry of compounds. In demonstration of this fact, 19 different structures, from the ACS Registry, are attached, in Appendix B, which show compounds containing phenyl groups that are substituted at the ortho position with a nitro or amine group and compounds containing phenyl groups that are substituted 3 or more times with nitro or amine groups. Thus, utilizing the known methods in the art for making these compounds, one of skill in the art would be able, without undue experimentation, to make compounds of Claims 8-11 wherein the R<sup>2</sup> group is a phenyl that is substituted at the ortho position and/or 3 or more times with nitro or amino groups.

Thus, pending Claims 8-11 are improperly rejected as being non-enabling.

**B. A Rejection, Under 35 USC 112, Second Paragraph, for Being Indefinite in that the Phrase "One or More" is Indefinite and as a Phenyl Ring Cannot Support Electron-Withdrawing Groups in the Ortho Position, Is Not Proper**

The Examiner states that, in Claim 8, the phrase "one or more C<sub>1</sub>-C<sub>6</sub> alkyl, C<sub>1</sub>-C<sub>6</sub> alkoxy, halo, nitro, amino or trifluoromethyl" is indefinite as there is no upper bound on the phrase "one or more".

Contrary to the Examiner's statement, the phrase "one or more" is not indefinite.

It is not required that an application describe claim limitations in detail greater than the invention warrants. (See Martin v. Mayer, 3 USPQ2d 1333 (Fed. Cir. 1987).) Rather, the application only needs description sufficient that it conveys to those skilled in the art that the

applicant has invented the subject matter claimed. (See *In re Kaslow*, 217 USPQ 1089, 1096 (Fed. Cir. 1983).)

In Claim 8, the phrase "one or more C<sub>1</sub>-C<sub>6</sub> alkyl, C<sub>1</sub>-C<sub>6</sub> alkoxy, halo, nitro, amino or trifluoromethyl" relates to possible substitution of the group R<sup>2</sup> wherein R<sup>2</sup> can be a C<sub>1</sub>-C<sub>6</sub> alkyl, trifluoromethyl or phenyl. It is well within the knowledge of one skilled in the art how many times a methyl, ethyl, propyl, butyl, pentyl, hexyl, trifluoromethyl or phenyl group may be substituted with one of the above-identified substituents. Therefore, based upon the disclosure provided in the present Application, does sufficiently describe to a skilled artisan the scope of the presently claimed invention.

Further, phrases such as "one or more" or "at least one", as used in chemical claims, are clearly understood by the skilled artisan. The clear understanding and acceptance of such claim language, by the skilled artisan, is further demonstrated by US Patent No. 5,684,135 (Claim 1), US Patent No. 5,653,960 (Claim 1), and US Patent No. 5,532,242 (Claim 1).

The Examiner also made the baseless assertion that a phenyl ring cannot support an electron-withdrawing group, such as nitro, in the ortho position.

As previously described herein, in the response to the Examiner's rejection under 35 USC §112, first paragraph, the Examiner's statement is incorrect.

Thus, pending Claim 8 is improperly rejected as being indefinite under 35 USC 112, second paragraph.

#### IX. Conclusion

In view of the above information, present Claims 8-11 are not properly rejected under 35 USC 112, first or second

paragraphs. Therefore, it is respectfully requested that the rejections of Claims 8-11 be withdrawn and that Claims 8-11 be allowed.

Date: 11 December 2003 Respectfully submitted,



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